



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,647	09/30/2003	Kwang Su Choe	YOR920030293US1 (16818)	4796
7590 03/07/2008				
Steven Fischman, ESQ. Scully, Scott, Murphy and Presser 400 Garden City Plaza Garden City, NY 11530				
EXAMINER				
PADGETT, MARIANNE L				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
03/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Continuing sheet for PTOL-303

continuation from:

(3) NOTE: the proposed amendments to the claims contained new issues of:

(i) changing the scope of the structure of the Si-containing substrate, from one that may alternatively have vacancies or voids in a region, to one where the region containing the vacancies or voids is necessarily porous, which was not previously required; and

(ii) putting the limitation of claim 12 into all independent claims 1 & 23-24, such that all of the claims now require a more restricted ion implantation dosage, which did not previously need to be considered with independent claims 23 or 24, nor dependent claims 2-11 & 13-22.

(5) Applicant's proposed amendments would overcome the rejection of claims with respect to Ikeda Tadashi (JP 09-064323), as limitation of claim 12 which has been put into all independent claims, was not previously rejected with respect to this reference.

The amendment of all independent claims to require the region of vacancies or voids to be porous would appear to remove the 102(b) or (c) rejections over Sadana et al. (5,930,643) or Norcott et al. (6,486,037 B2) respectively.

(8) With respect to the Declaration under 1.131, applicants submitted an unsigned before (10/15/2007) the final rejection of 12/21/2007 & had the opportunity (10/18/2007) before the final rejection was issued to correct this defect & did not, hence clearly could have presented the document earlier.

Furthermore, the declaration is deficient because:

(i) the declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or in a WTO member country. See MPEP 715.07(c) & 35 USC 104.

(ii) The supplied exhibits are ineffective for showing all features of the independent claims as asserted in the declaration. Particularly, the claimed thickness range of "about 100 nm or less" was not found in the evidence of conception & reduction to practice. Other problems were also noted with respect to the supplied evidence, specifically, in section 3 applicants state that exhibit A is supposed to teach the basic features of claims 1, 23 & 24, however exhibit A (Disclosure YOR8-2001-0417) specifically states NO ion implantation is necessary to form the SOI substrate, hence is completely contrary to the claimed invention. Although exhibit B (Disclosure YOR8-2001-0812) does contain most of the features of the independent claims, including $<1\text{E}17\text{ cm}^2$ which encompasses the claim dosage as in the proposed amendment, as well as a specific example ($5\text{E}17\text{ cm}^2$), which is one and of the dosage range originally claim 12, it only creates buried oxide layers of $<500\text{ \AA}$, i.e. 50 nm or less, thus does not provide for all of the **claimed thickness** range. Also exhibit B is **incomplete**, as the declaration indicates that electron micrographs are supposed to be attached to it & part of the exhibit, how the effort there are none in the PTO scanned file & while the examiner assumes that the three little framed pictures of eyes in exhibit B are icons that presumably lead to these micrographs on applicants' computer, but the photocopy of these icons is quite useless to the examiner. If the missing evidence (rest of the thickness range) is present on the electron micrographs, it cannot be determined by the examiner as they are not present in the PTO file, nor were they apparently submitted with the After Final, as the number of pages in the filed matches the number of pages listed as submitted on the electronic acknowledgment receipt.

(iii) While not an error detrimental to the effectiveness of the 1.131 Declaration, applicants should note that the effect of filing date of USPN 6,800,518 to Bendernagle et al. is December 30, 2002, not December 20, 2002 (so applicants were still swearing to a date that was before the patent filing date).

(11) The request for reconsideration does not place the application into condition for allowance because: (i) the 1.131 Declaration was not entered & was deficient (see (8) above), hence

Art Unit: 1792

cannot be used to remove rejections based on Bendernagel et al.; (ii) while the proposed amendment would remove the 102 rejections over Sadana et al. (643) or Norcott et al. (037), the new requirement of the region being porous needs to be considered with respect to obviousness, alone or in combination with other references, hence is a new issue that requires further consideration; (iii) the amendment of all independent claims to require a narrower & lower oxygen dosage for O-ion implantation than previously required, needs reevaluation with respect to Houston et al. & dependent claims 2-11, 13-15, 18-22 & 25, as well as independent 23-24, to determine if this change in scope has any effect on the limitations therein, which were previously considered in combination with the broader range that encompassed the previously wider range of narrower range, considering the narrow range no longer has specific overlap with Houston et al.'s generally discussed dosage values. For instance, in light of the amendments, consideration of overlapping &/or analogous teachings in Houston et al. & Sadana et al. or Norcott et al. will require consideration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on M-F from about 8:30 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks, can be reached at (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

Art Unit: 1792

direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Marianne L. Padgett/
Primary Examiner, Art Unit 1792

MLP/dictation software

2/28/2008